

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CUSTOMER NO. 22927

Applicant: Walker et al.
Application No.: 10/784,845
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Title: METHOD AND APPRATUS FOR SETTING GAME PARAMETERS

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Group Art Unit: 3714
Examiner: Coburn, Corbett B.

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
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APPEAL BRIEF

Sir:

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the decision of the Examiner in the Final Office Action mailed 27 April 2006, rejecting claims **1-18** and **38** pursuant to 37 C.F.R. § 41.37.

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(1) REAL PARTY IN INTEREST

The present application is owned by Walker Digital LLC, which is a privately held entity with a principle place of business at 2 High Ridge Park, Stamford CT 06905.

(2) RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences to the best of Appellant's knowledge.

(3) STATUS OF CLAIMS

Claims 1-18 and 38 are pending with a final rejection made 27 April 2006.

Claims 19-37 are canceled.

Claims 1-18 and 38 are the subject of the current appeal.

(4) STATUS OF AMENDMENTS

All amendments have been entered to the best of Appellant's knowledge.

(5) SUMMARY OF CLAIMED SUBJECT MATTER

A concise explanation of the independent claim being appealed is provided below. The summary includes sufficient information about the claimed subject matter so that an informed review of the Examiner's adverse determination of patentability can be made.

As required by 37 C.F.R. § 41.37(c)(1)(v), reference is made to the Specification and Drawings, as appropriate. Any such reference:

- (i) is by way of example of the claimed subject matter only;
- (ii) is to be considered as potentially useful in clarifying the particular subject matter of the particular independent claim being explained (and not other claims or "the invention" as a whole), unless explicitly stated otherwise; and
- (iii) is not to be considered as broadening or narrowing the scope of any recited term from its meaning to one of ordinary skill in the art, unless explicitly stated otherwise.

Claim 1 (the only independent claim) is a method claim that determines a game parameter (step 702). The game parameter is further clarified as serving to control at least one element of a game such that it affects a manner in which the game will be conducted. This clarification is consistent with the definition of the term "game parameter" which is provided on

page 5, lines 16-20 of the specification as filed. A range of values associated with the game parameter is determined (step 704). Symbols are displayed on reels wherein each symbol represents a potential value for the game parameter (step 706). A symbol is selected at random (step 708) and the game parameter is set to an actual value based on the symbol and its represented potential value (block 710). The game is played with one of element of the game being controlled by the actual value of the game parameter (block 712). This process is illustrated in Figure 7, and a detailed discussion begins at page 26, line 16 extending to page 34, line 14 of the specification as filed.

An exemplary embodiment of the present invention is a gaming device such as a slot machine wherein game parameters are set or modified through the use of random events, such as the spinning of the reels of the slot machine. A more specific example is a slot machine with a variable payout multiplier (see, for example, claim 6). The variable payout multiplier is a game parameter. For the sake of example, the range of values for the payout multiplier may be one to ten. The symbols on the reels of the slot machine are mapped to values within the range of values. E.g., a cherry is mapped to one, an apple to two, a plum to three, an orange to four, a bar to five, a bell to six, etc. A symbol from the reels is selected at random. For example, the reels are spun, and the symbol that appears on the first reel is selected. The payout multiplier is then set to the value associated with that symbol (e.g., if a plum was on the first reel, the payout multiplier is set to three). Game play then occurs on the slot machine with all payouts being multiplied by three. Numerous other examples are provided in the disclosure, and this example is intended to help illustrate the nature of how the invention might be implemented rather than discuss a particular claim element or claim limitation.

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether claims 1-5, 8, and 38 are properly rejected under 35 U.S.C. § 102(b) as being anticipated by Marshall Fey, Slot Machines: A Pictorial History of the First 100 Years.

B. Whether claims 6, 7, and 9-18 are properly rejected under 35 U.S.C. § 103 as being unpatentable over Fey in view of U.S. Patent No. 6,068,552 to Walker et al.

(7) ARGUMENT

A. Introduction

The Patent Office has set forth improper rejections under 35 U.S.C. §§ 102 and 103 by stretching the “game parameter” language of the claim beyond what the term’s definition and function within the claim supports. When all the elements surrounding the game parameter language are considered, it is readily apparent that the claims define over the rejections of record. In particular, an actual value of the game parameter is never set based on a randomly selected displayed symbol.

B. Summary of References

1. Marshall Fey, Slot Machines: A Pictorial History of the First 100 Years

This reference, hereinafter referred to as “Fey”, in relevant part, is a one-page description of various machines sold Caille and Mills Novelty during the approximate period of 1901 to 1913. The brief description discusses that the payout wheel could have individual stops plugged. In another device, the hold percentage could be varied between thirty and ninety percent. In still a third “future pay” device, the payout could be varied between fifty and seventy-five percent. The one image on the page is of the Caille 1901 Quintette, which shows five five-reel poker hands, such that up to five players may bet simultaneously on one or more of the five individual poker hands.

2. U.S. Patent No. 6,068,552 to Walker et al.

This reference, hereinafter “Walker ‘552’”,

... provides a **player** the ability to modify at least one parameter of the slot machine. The slot machine then modifies other parameters to ensure a desired house advantage. In one embodiment, the slot machine allows the player to customize odds, payout schedules, or wager amount by trading off one variable for another to maintain a constant house advantage.

Walker ‘552 col. 2, lines 3-10 (emphasis added). Thus, for example, a **player** may change the payout for “7-7-7” on a slot machine from one hundred credits to two hundred credits, and the slot machine decreases the payout for “cherry-cherry-cherry” to compensate (see, for example, Walker ‘552, col. 5, lines 36-53). The changes to the payout tables are player initiated and not random.

C. Statutory Standards

1. 35 U.S.C. § 102(b)

Section 102 of the Patent Act provides the statutory basis for an anticipation rejection and states *inter alia*:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States. . . .

Anticipation is a question of fact. *In re Hyatt*, 211 F.3d 1367, 1371, 54 U.S.P.Q.2d 1664, 1667 (Fed. Cir. 2000) (citations omitted). The Federal Circuit’s test for anticipation has been set forth numerous times. “It is axiomatic that for prior art to anticipate under 102 it has to meet every element of the claimed invention, and that such a determination is one of fact.” *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986). “To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter.” *PPG Indus. Inc. v. Guardian Indus. Corp.*, 75 F.3d 1558, 1566, 37 U.S.P.Q.2d 1618, 1624 (Fed. Cir. 1996) (citations omitted). Further, “a finding of anticipation requires that the publication describe all of the elements of the claims, **arranged as in the patented device.**” *C.R. Bard Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1349, 48 U.S.P.Q.2d 1225, 1230 (Fed. Cir. 1998). (emphasis added and citations omitted). *Accord In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990).

When determining if a reference shows a claim element, the Patent Office is encouraged to give claim elements their broadest reasonable interpretation consistent with the specification. *In re Hyatt*, 211 F.3d at 1372, 54 U.S.P.Q.2d at 1667; MPEP § 2111. The leniency of the broad interpretation is allowed for two primary reasons. First, claim elements should be interpreted broadly during examination so as to reduce the likelihood that a claim be given broader interpretation during litigation than during examination. Second, the Applicant always has the opportunity to amend the claim language to distinguish the invention from the cited references. *In re Hyatt*, 211 F.3d at 1372, 54 U.S.P.Q.2d at 1667.

Despite the admonition to the Patent Office that it should interpret the claim broadly, the Federal Circuit has repeatedly stated that the interpretation must be consistent with the specification. *In re American Academy of Science Tech Ctr.*, 367 F.3d 1359, 1364, 70 U.S.P.Q.2d 1827, 1830 (Fed. Cir. 2004); *In re Thrift*, 298 F.3d 1357, 1364, 63 U.S.P.Q.2d 2002,

2006 (Fed. Cir. 2002); *In re Hyatt*; *In re Morris*, 127 F.3d 1048, 1054, 44 U.S.P.Q.2d 1023, 1027 (Fed. Cir. 1997). Furthermore, the Federal Circuit has, on more than one occasion, indicated that reasonableness is determined as it would be interpreted by one of ordinary skill in the art. *In re American Academy of Science Tech Ctr.*, 367 F.3d at 1364, 70 U.S.P.Q.2d at 1830; *In re Morris*, 127 F.2d at 1054, 44 U.S.P.Q.2d at 1027; *In re Bond*, 910 F.2d at 833, 15 U.S.P.Q.2d at 1567. Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *In re American Academy of Science Tech Ctr.*, 367 F.3d at 1364, 70 U.S.P.Q.2d at 1830; *In re Morris*, 127 F.2d at 1054, 44 U.S.P.Q.2d at 1027. The Patent Office has incorporated these standards into the MPEP at § 2111.01.

When the term “game parameter” is afforded a definition consistent with the definition in the specification, and all the claim elements are considered, it is clear that Fey does not anticipate the claims.

2. 35 U.S.C. § 103

Section 103(a) of the Patent Act provides the statutory basis for an obviousness rejection and reads as follows:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Courts have interpreted 35 U.S.C. § 103(a) as a question of law based on underlying facts. As the Federal Circuit stated:

Obviousness is ultimately a determination of law based on underlying determinations of fact. These underlying factual determinations include: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) the extent of any proffered objective indicia of nonobviousness.

Monarch Knitting Mach. Co. v. Sulzer Morat GmbH, 139 F.3d 877, 881, 45 U.S.P.Q.2d 1977, 1981 (Fed. Cir. 1998) (internal citations omitted).

Once the scope of the prior art is ascertained, the content of the prior art must be properly combined. Initially, the Patent Office must show that there is a suggestion to combine the references. *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). To

show that there is a suggestion to combine the references, the Patent Office must first state a motivation to combine the references, and second, the Patent Office must support the stated motivation with actual evidence. *Id.* While there are myriad sources available to show the motivation to combine the references, the range of available sources does not diminish the requirement for actual evidence. *Id.* If a proposed combination would render the reference being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed combination. *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

After the combination has been made, for a *prima facie* case of obviousness, the combination must still teach or fairly suggest all of the claim elements. *In re Royka*, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (C.C.P.A. 1974); MPEP § 2143.03. If the Patent Office must modify the combination further to show all the claim elements or to rearrange the elements of the combination to align with the arrangement of the claim, the Patent Office must show that there is a suggestion to modify the combination. *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992).

Appellant notes that the Patent Office may not modify a combination through substitution of an equivalent unless the equivalency is recognized in the art. This equivalency cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents. *In re Ruff*, 256 F.2d 590, 118 U.S.P.Q. 340 (CCPA 1958); *In re Scott*, 323 F.2d 1016, 139 U.S.P.Q. 297 (CCPA 1963); MPEP § 2144.06.

If a claim element is missing after the combination is made, then the combination does not render the claimed invention obvious, and the claims are allowable. As stated by the Federal Circuit, “[d]uring patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. If the PTO fails to meet this burden, then the applicant is entitled to the patent.” *In re Glaug*, 283 F.3d 1335, 1338, 62 U.S.P.Q.2d 1151, 1152 (Fed. Cir. 2002) (internal citation omitted).

Since the references do not teach or suggest randomly setting the game parameter as recited in the independent claim, the claims are non-obvious.

D. Argument

1. Claims 1-5, 8 and 38 Are Not Anticipated

Claims 1-5, 8, and 38 are not anticipated by Fey. While the Patent Office has varied its interpretation of the claim element *game parameter*, a *game parameter* performing the functions recited in the claims is not shown by Fey. Since Fey does not teach or suggest this element, and anticipation requires identity between the reference and the claim, Fey does not anticipate claim 1 or its dependent claims 2-5, 8, and 38.

a. The Game Parameter is Not the Paytable

The Patent Office initially interpreted the game parameter to be a payable. Under this interpretation, Fey does not anticipate claim 1.

Claim 1 recites:

determining a **game parameter**, the **game parameter** serving to control at least one element of a game such that it affects a manner in which the game will be conducted;
determining a range of values associated with the **game parameter**;
displaying at least one symbol on a reel, each symbol representing a potential value within the range of values associated with the **game parameter**;
selecting at random at least one of the displayed symbols;
setting an actual value of the **game parameter** based on the randomly selected displayed symbol; and
controlling the at least one element of the game using the actual value such that the manner in which the game is conducted subsequent to the setting of the actual value is affected by the actual value.

(emphasis added). In the first Office Action of April 7, 2005, the Patent Office stated “Fey teaches determining a game parameter and a range of values associated with the game parameter (i.e., it has a payable).”¹ In the Final Office Action of April 27, 2006, the Patent Office repeated its statement that “Fey teaches determining a game parameter and a range of values associated with the game parameter (i.e., it has a payable).”² Further, the Patent Office stated that “setting the parameter in the factory (i.e., the payable) affects the amount paid for the winning combination.”³ The Patent Office went on to explain that the payable controls which combinations win and how much is paid.⁴

Appellant initially notes that Fey has no specific mention of a payable, how such a payable might be determined, how a range of values associated with the payable might be determined, or how actual values of the payable are set. Fey’s terse discussion merely mentions

¹ Office Action of April 7, 2005, page 3, lines 14-16.

² Office Action of April 27, 2006, page 2, lines 12-14.

³ Office Action of April 27, 2006, page 6, lines 9-10.

⁴ Office Action of April 27, 2006, page 2, lines 14-16.

that there is a payout wheel. Likewise, Fey discloses changing the automatic percentage of the device, but there is no discussion of a payable *per se*. As such, Fey does not support the Patent Office's interpretation of the reference in sufficient detail to sustain an anticipation rejection.

Assuming, *arguendo*, that there is a payable within Fey, the Patent Office's explanations provide the following annotations to claim 1:

- determining a **paytable**, the **paytable** serving to control [which combinations win and how much is paid] of a game such that it affects a manner in which the game will be conducted [the amount paid for the winning combination];
- determining a range of values associated with the **paytable** [the values of the payable];
- displaying at least one symbol on a reel, each symbol representing a potential value within the range of values associated with the **paytable**;
- selecting at random at least one of the displayed symbols;
- setting [at a factory] an actual value of the **paytable** based on the randomly selected displayed symbol; and
- controlling [which combinations win and how much is paid] of the game using the actual value such that the manner in which the game is conducted subsequent to the setting of the actual value is affected by the actual value.

The Patent Office's analysis falls short of anticipation at "*setting an actual value of the payable based on the randomly selected displayed symbol. . .*" That is, using the Patent Office's interpretation, an actual value of the payable must be set based on the randomly selected displayed symbol. However, setting the values of the payable, even if it occurs in the factory, is never done based on the randomly selected displayed symbol. Fey certainly does not teach spinning the reels and setting an actual value of the payable based on the randomly displayed symbol.

Perhaps recognizing this deficiency, the Patent Office subtly shifted its language, stating "[t]he **payout** depends on which symbols appear on the **payline**."⁵ The **payout** is not the same thing as the **paytable**. To be internally consistent as required in an anticipation analysis, the *game parameter* cannot simultaneously be both the payable and the payout. To the extent that the Patent Office relies on an interpretation that the *game parameter* is Fey's payable, it is readily ascertainable that an actual value of Fey's payable is not set based on the randomly selected displayed symbol, and Fey does not anticipate claim 1 or its dependent claims 2-5, 8, and 38.

⁵ Office Action of April 27, 2006, page 2, lines 21-22.

b. The Game Parameter is Not the Payout

In response to Appellant's arguments in the response filed June 27, 2006⁶ that explained how the payable could not be the *game parameter*, the Advisory Action clarified that the Patent Office was equating the *game parameter* with the payout, specifically stating, "the game parameter is the amount paid for a particular combination of symbols."⁷ However, even this clarification does not establish anticipation. Construing the *game parameter* to be the amount paid for a particular combination of symbols effectively (but improperly) eliminates several distinct elements from the claim. That is, under this interpretation, a single element in Fey is being used to show three distinct elements of claim 1. Furthermore, even under this interpretation, Fey does not teach "*setting an actual value of the game parameter based on the randomly selected displayed symbol. . . .*" Anticipation requires identity between the claim and the reference. Since such identity is lacking, claim 1 is not anticipated, nor are the dependent claims 2-5, 8, and 38.

1) The Interpretation Improperly Merges Claim Elements

The interpretation advanced in the Advisory Action improperly merges three distinct elements within the claim. Specifically, claim 1 recites three distinct elements relating to the *game parameter*, which, under the Patent Office's interpretation are merged into a single step within Fey. Specifically, claim 1 recites "determining a **game parameter**, the **game parameter** serving to control at least one element of a game such that it affects a manner in which the game will be conducted"; "determining a range of values associated with the **game parameter**"; and "setting an actual value of the **game parameter** based on the randomly selected displayed symbol. . . ." Each of these is its own claim element, none of which can be ignored in an anticipation analysis.

Appellant's response to the Advisory Action's clarification is better understood by approaching the question of anticipation from another direction. Appellant notes that there is a symmetrical test regarding infringement and anticipation. The Federal Circuit quoted this maxim with approval in 1987:

As the defendants put it, "that which infringes if later in time will anticipate if earlier than the patent . . . The inquiry as to anticipation is symmetrical with the inquiry as to infringement of a patent." The classic test of

⁶ Response filed June 27, 2006, page 5, line 20-page 6, line 16.

⁷ Advisory Action of July 14, 2006, page 2, lines 6-7.

anticipation provides: “That which will infringe, if later, will anticipate, if earlier. Thus a claim fails to meet the novelty requirement if it covers or reads on a product or process found in a single source in the prior art.”

Lewmar Marine, Inc. v. Bariant, Inc., 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987) (quoting the district court’s slip opinion at 22). While endorsing this line of thought, the Federal Circuit cautioned that anticipation had shifted its definition from the classic test and, under the current statute, the test could be restated to “[t]hat which would *literally* infringe if later in time anticipates if earlier than the date of invention.” *Id.* (emphasis in original). Thus, only if the devices of Fey *literally* infringe if later in time, would the devices anticipate claim 1, if earlier than the date of the invention.

Appellant further notes that in an infringement analysis, “[e]ach element contained in a patent claim is deemed material to defining the scope of the patented invention. . . .” *Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 29, 41 U.S.P.Q.2d 1865, 1871 (1997). Put another way, all claim terms are presumed to have meaning in the claim. *Innova/Pure Water Inc. v. Safari Water Filt. Sys. Inc.*, 381 F.3d 1111, 1119, 72 U.S.P.Q.2d 1001, 1007 (Fed. Cir. 2004). “All limitations in a claim must be considered meaningful.” *Lantech, Inc. v. Keip Mach. Co.*, 32 F.3d 542, 546, 31 U.S.P.Q.2d 1666, 1670 (Fed. Cir. 1994).

Under this analysis, it is readily apparent that Fey does not infringe claim 1. Using the Advisory Action’s interpretation of *game parameter*, claim 1 reads as follows:

determining a[n] **amount paid for a particular combination of symbols**, the **amount paid for the particular combination of symbols** serving to control [which combinations win and how much is paid] of a game such that it affects a manner in which the game will be conducted;

determining a range of values associated with the **amount paid for the particular combination of symbols**;

displaying at least one symbol on a reel, each symbol representing a potential value within the range of values associated with the **amount paid for the particular combination of symbols**;

selecting at random at least one of the displayed symbols;

setting [at a factory] an actual value of the **amount paid for the particular combination of symbols** based on the randomly selected displayed symbol; and

controlling [which combinations win and how much is paid] of the game using the actual value such that the manner in which the game is conducted subsequent to the setting of the actual value is affected by the actual value.

To infringe claim 1 literally, Fey must have all the elements of claim 1. Fey does not have all the elements. Fey may determine an amount paid for a particular combination of symbols, but if so, Fey has no separate step of determining a range of values associated with the amount paid for a particular combination of symbols. Rather, once the amount paid for a particular combination of symbols is determined, no further determination of a range of values occurs as recited by the claim.

Likewise, once the amount paid for a particular combination of symbols is determined, Fey does not set an actual value of the amount paid for a particular combination of symbols based on the randomly selected displayed symbol. Rather, Fey pays an amount for a particular combination, but the amount paid is already determined, and there is no separate step of setting as recited in the claim.

Since Fey does not have two elements required to infringe claim 1 literally, Fey cannot anticipate claim 1 under the anticipation/literal infringement symmetry. Instead, the Patent Office's interpretation merges the three distinct claim elements in such a manner as to read the elements out of the claim. Since anticipation requires identity between the claim and the reference, it is clear that Fey does not anticipate claim 1 or its dependent claims 2-5, 8, and 38.

2) Fey Does Not Teach Setting Based on a Random Symbol

Even if the reverse infringement/anticipation analysis is not persuasive, Fey does not teach "setting [at the factory] an actual value of the amount paid for the particular combination of symbols based on the randomly selected displayed symbol. . ." as argued by the Patent Office. Fey does not describe how the operator sets a given payout for a particular combination, but such setting would presumably be done as part of the creation of the machine and would not be based on a random symbol. Appellant notes that, as discussed above, Fey pays the actual value of the amount paid for a particular combination of symbols based on the randomly selected displayed symbol. However, **paying** based on the randomly selected displayed symbols is not claimed. The claim recites setting the actual value of the game parameter based on the randomly displayed symbol and controlling at least one element of the game using the actual value.

If the Patent Office attempts to construe *setting* to cover paying, such a construction exceeds any reasonable interpretation of the term "setting" that would be consistent with the specification to anyone skilled in the art.

In short, Fey does not teach or suggest setting the game parameter based on the randomly displayed symbol as recited in the claim. Since Fey does not teach this element, Fey cannot anticipate claim 1 or dependent claims 2-5, 8, and 38.

For these reasons, Fey does not anticipate the claims, and Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims.

2. Claim 5 Is Not Anticipated by Fey

Appellant separately argues claim 5 as independently allowable over the Fey. Specifically, claim 5 recites that the “*game parameter represents a number of game symbols with which to start a session.*” Since the Patent Office has specifically asserted that the game parameter is an amount paid for a particular combination of symbols, the Patent Office is not at liberty to assert that the game parameter is a number of game symbols with which to start a session in its analysis of claim 5. Anticipation requires identity between the reference and the claim. In the Office Action of April 27, 2006, the Patent Office asserts that “the game parameter **could** also represent a number of game symbols”.⁸ Anticipation requires more than possibilities. Anticipation requires identity between the reference and the claim language. The fact that something **could** be present is insufficient to establish anticipation. The Patent Office has not addressed this discrepancy since clarifying its interpretation of game parameter. In the absence of any clarification, claim 5 is clearly not anticipated.

3. Claim 8 Is Not Anticipated by Fey

Appellant separately argues claim 8 as independently allowable over the Fey. Specifically, claim 8 recites that the “*game parameter represents a number of reels used in a game.*” Since the Patent Office has specifically asserted that the game parameter is an amount paid for a particular combination of symbols, the Patent Office is not at liberty to assert that the game parameter is a number of reels used in the game in its analysis of claim 8. Anticipation requires identity between the reference and the claim. In the Office Action of April 27, 2006, the Patent Office asserts that “the game parameter **could** represent a number of reels used in the game”.⁹ Anticipation requires more than possibilities. Anticipation requires identity between the reference and the claim language. The fact that something **could** be present is insufficient to establish anticipation. The Patent Office has not addressed this discrepancy since clarifying its

⁸ Office Action of April 27, 2006, page 3, line 6 (emphasis added).

⁹ Office Action of April 27, 2006, page 3, line 11 (emphasis added).

interpretation of game parameter. In the absence of any clarification, claim 8 is clearly not anticipated.

4. Claims 6, 7, and 9-18 Are Not Obvious

a. The Motivation to Combine Is Not Compelling

The Patent Office states that

Walker teaches a modern gaming machine that is adapted to change the gaming parameters on the fly. Walker teaches that allowing such changes will induce players to continue playing for extended periods of time. It would have been obvious to one of ordinary skill in the art at the time for the invention to have modified Fey in view of Walker to have a modern slot machine that is capable of changing parameters on demand in order to induce players to continue playing for extended periods of time.¹⁰

Assuming, *arguendo*, that Walker '552 does teach what is alleged, the conclusion drawn by the Patent Office is not a necessary outcome of Walker '552's teachings. Mere recognition of a problem (in this case a desire to induce players to continue playing for extended periods of time) does not render obvious the eventual solution. *Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc.*, 381 F.3d 1371, 1377, 72 U.S.P.Q.2d 1333, 1337 (Fed. Cir. 2004) (stating "[t]here is an important distinction between the general motivation to cure an uncured disease (for example, the disease of multiple forms of heart irregularity), and the motivation to create a particular cure."). Under this case law, a general teaching that it is desirable to induce players to continue playing for extended periods of time does not necessarily compel the combination. Rather, an artisan of ordinary skill in the art that is seeking to induce players to continue playing for extended periods of time would stop at Walker '552, and would not seek to combine Walker '552 with another reference. The Patent Office has not identified any deficiency in Walker '552 that would cause the artisan to feel the need to combine Walker '552 with Fey. Per the Federal Circuit's current test, the motivation must suggest the combination. If a single reference completely satisfies the motivation, then the motivation does not suggest a combination. As such, the motivation advanced by the Patent Office is insufficient to support the combination. Since the motivation is insufficient to support the combination, the combination is improper. Since the combination is improper, the references must be considered individually. Since the Patent Office has not shown how the references individually anticipate or render obvious the

¹⁰ Office Action of April 27, 2006, page 5, lines 14-20 (underlining added).

claims, the Patent Office has not met its burden in establishing a proper obviousness rejection, and Appellant is entitled to a patent.

Appellant further notes that the combination advanced by the Patent Office renders Walker '552 unsuitable for its intended purpose by eliminating the ability of the player to change the parameters. That is, Walker '552 provides the player the ability to modify the game parameters. Making the parameters change as a function of a randomly determined symbol vitiates the player's ability to initiate the changes. Making a reference unsuitable for its intended purpose is evidence of non-obviousness. *In re Gordon*.

b. The Patent Office Impermissibly Relies On Appellant's Disclosure

Even if the combination is proper, a point which Appellant does not concede, the Patent Office impermissibly relies on Appellant's disclosure to assert equivalence amongst various elements. In particular, the Patent Office states "Applicant teaches that all of these various game parameters are equivalent."¹¹ "To rely on an equivalence known only to the applicant to establish obviousness is to assume that his disclosure is part of the prior art. The mere statement of this proposition reveals its fallaciousness." *In re Ruff*, 256 F.2d at 598, 118 U.S.P.Q. at 347. Thus, it is irrelevant whether Appellant has equated the game parameters. Rather, the Patent Office must show that the equivalence was known in the art. Since the Patent Office has not done so, the Patent Office is not free to substitute game parameters from amongst those disclosed in the present application. To the extent that the § 103 rejections rely on this sort of substitution, the rejections are improper.

Even if it were appropriate to use Appellant's disclosure to show equivalence between different game parameters (a point which Applicant does not concede), the Patent Office has not provided a proper motivation to modify the combination of Fey and Walker '552 to include these alternate parameters. The Patent Office asserts that such a change is a design choice, but offers no evidence that such a substitution was known in the art. Absent such proof, the Patent Office must provide actual evidence to modify the combination. *In re Dembiczak*; *In re Fritch*.

c. The Patent Office Has Not Proven *Prima Facie* Obviousness

Since the Patent Office has not articulated a proper motivation to combine the references, and since the Patent Office is impermissibly relying on Appellant's disclosure to show certain elements, the Patent Office has not properly shown where all the elements of the claims are

¹¹ Office Action of April 27, 2006, page 5, lines 20-21.

taught or suggested in the prior art. In other words, the Patent Office has not established *prima facie* obviousness. Since the Patent Office has not established obviousness, the claims are allowable.

Even if the Patent Office has properly combined and modified the references in the manner advanced by the Patent Office, the combination does not teach setting an actual value of the game parameter based on the randomly selected displayed symbol as recited in **claim 1** (and by extension recited in all the dependent claims). As explained above, Fey does not teach this element. Likewise, Walker '552 does not teach this element because Walker '552 teaches the player setting the game parameter, not setting the game parameter through a random process. Thus, even combined, the two references do not teach or suggest the element. Since the combination does not teach or suggest the claim element, the combination does not establish obviousness, and the claims are allowable.

E. Conclusion

For at least the reasons articulated above, Appellant requests that he Board reverse the Examiner and instruct the Examiner to allow the claims.

F. Costs

Appellant authorizes that the fee for filing this Appeal Brief as required by 37 C.F.R. § 1.17(c) be charged to Deposit Account No. 50-0271. If any additional fees are required in association with this Appeal Brief, the Commissioner is hereby authorized to charge them to Deposit Account No. 50-0271 and consider this a petition to that end.

Respectfully submitted,

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Date

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(8) CLAIMS APPENDIX

1. A method comprising:

determining a game parameter, the game parameter serving to control at least one element of a game such that it affects a manner in which the game will be conducted;
determining a range of values associated with the game parameter;
displaying at least one symbol on a reel, each symbol representing a potential value within the range of values associated with the game parameter;
selecting at random at least one of the displayed symbols;
setting an actual value of the game parameter based on the randomly selected displayed symbol; and
controlling the at least one element of the game using the actual value such that the manner in which the game is conducted subsequent to the setting of the actual value is affected by the actual value.

2. The method of claim 1, further including:

initiating game play using the actual value of the game parameter.

3. The method of claim 1, further including:

continuing game play using the actual value of the game parameter.

4. The method of claim 1, further including:

ending game play using the actual value of the game parameter.

5. The method of claim 1 wherein the game parameter represents a number of game symbols with which to start a session.

6. The method of claim 1 wherein the game parameter represents a number by which payouts will be multiplied for a given number of handle pulls.

7. The method of claim 1 wherein the game parameter represents a maximum number of spins allowed before player is ineligible for a puzzle completion bonus.

8. The method of claim 1 wherein the game parameter represents a number of reels used in a game.
9. The method of claim 1 wherein the game parameter represents a number of bonus symbols on each reel which initiate a bonus game.
10. The method of claim 1 wherein the game parameter represents a rate of expiration of player collected symbols.
11. The method of claim 1 wherein the game parameter represents a rate of accumulation of complementary (comp) points.
12. The method of claim 1 wherein the game parameter represents a progression rate of a progressive jackpot.
13. The method of claim 1 wherein the game parameter represents a payout for a particular symbol combination.
14. The method of claim 1 wherein the game parameter represents a probability of a particular symbol combination occurring.
15. The method of claim 1 wherein the game parameter represents an amount of wager required per spin.
16. The method of claim 1 wherein the game parameter represents a probability of a player getting into a bonus round.
17. The method of claim 1 wherein the game parameter represents a number of puzzle pieces that need to be collected by a player during a puzzle game.

18. The method of claim 1 wherein the game parameter represents a probability of bonus round payouts occurring.

19-37. (Canceled)

38. The method of claim 1, wherein determining a game parameter, the game parameter serving to control at least one element of a game such that it affects a manner in which the game will be conducted, comprises:

determining a game parameter, the game parameter serving to control at least one element of a game such that it affects a manner in which rewards are awarded for the game.

(9) EVIDENCE APPENDIX

There is no evidence for the evidence appendix.

(10) RELATED PROCEEDINGS APPENDIX

There are no related proceedings to be included in this Appendix.